

REMARKS

Claims 1-23 are pending in the present application. Claims 1, 11, 12, and 22-23 have been amended. Reconsideration of the claims is respectfully requested. Amendments to the claims have been made for purposes of correcting an antecedent basis problem and were not made in response to any art rejection. These amendments do not change the scope of the claims. Applicants thank the examiner for the interview. During the interview on Wednesday April 7th, the examiner indicated that the amendments to the claims would place the case in a condition for allowance but would check with her supervisor to make sure. On April 15th, the examiner indicated that the proposed amendments to the claims were acceptable and overcame the rejection in the office action.

I. 35 U.S.C. § 103, Anticipation

The examiner has rejected claims 1-2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 as being anticipated by McDowell et al., United States patent number 6,438,583 ("*McDowell*") in view of Henderson, United States patent number 6,185,603 ("*Henderson*"). In the telephone conference with the examiner, it was clarified that the statement regarding section 102 in paragraph 2 was a typographical error. This rejection is respectfully traversed.

In rejecting the claims, the examiner stated:

In considering claims 1, 4, 11-12, 15, and 22, McDowell discloses a system and method for re-routing electronic mail messages, the method comprising:

determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient (*Col 8, lines 32-37, McDowell discloses the re-route server, after receiving e-mail; determines if the recipient of the e-mail is a re-route customer, wherein if the recipient is determined to be a re-route customer then it is determined that the e-mail for the recipient is to be forwarded to the recipient's "toAccount" address or another address provided by the recipient*);

while McDowell discloses a system for re-routing or forwarding e-mail from a prior or non-working address to a new address of a recipient, McDowell does not particularly disclose including an indicator identifying the message as forwarded from an old address if the electronic message is

to be forwarded to another address associated with the recipient. Nonetheless, including an indicator that identifies a message as forwarded and from where it was forwarded is well known in the art as evidenced by Henderson.

In similar art Henderson discloses a system for the delivery of e-mail and alerting messages wherein typical email messages include normal headers and a message portion that indicates the source of the message and from where it was forwarded (col. 5, lines 52-55).

Given the teachings of Henderson a person having ordinary skill in the art would have readily recognized the uses and advantages of modifying the system for re-routing e-mail messages, as disclosed by McDowell, by including the well known indicator that identifies the message as being forwarded from an old address, such as disclosed by Henderson, in order to distinguish the forwarded e-mail from the regularly received e-mail and also to inform the user that the e-mail was sent from a known and secure source.

Office Action, January 30, 2004, pages 2-3.

These two references, however, cannot be interpreted and combined in the manner recited by the examiner to reach the presently claimed invention. The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this particular case, the examiner has failed to establish a *prima facie* case of obviousness based on the prior art. More specifically, the cited references cannot be interpreted in the manner stated by the examiner in the office action. Specifically, *Henderson* does not teach or suggest the use of including an indicator to identify the message as being forwarded from an old address as recited in claim 1.

A. All claim limitations must be considered, especially when missing from prior art.

In comparing *Henderson* to the claimed invention, the features of the presently claimed invention may not be ignored in an obviousness determination. Amended claim 1 reads as follows:

- I. A method in a data processing system for processing an electronic mail message, the method comprising:
determining whether the electronic mail message is to an old address for a recipient that is to be forwarded to another address associated

with the recipient, wherein the old address is no longer a current address for the recipient;

including an indicator identifying the electronic mail message as being forwarded from the old address if the electronic mail message is to be forwarded to the another address associated with the recipient, wherein the indicator indicates that the old address is no longer current for the recipient; and

sending the electronic mail message with the indicator to the another address if the electronic mail message is to be forwarded to the another address associated with the recipient.

Independent claims 11, 12, and 22 include similar features. The indicator in these claims is placed into the electronic mail message, which is also referred to as an email message. The amendments to these claims make it clear that the forwarding occurs from an old email address for the recipient to another email address to the recipient in which the old address is no longer a current address.

In this particular case, *Henderson* does not teach or suggest including an indicator that identifies the message as being forwarded from an old address for the user. Instead, *Henderson* teaches in the cited section providing routing information for an e-mail message that shows the path from the sender to the recipient. For example, the cited section of *Henderson* teaches:

FIG. 3 depicts an example of a typical email message along with the normal headers. The portion of the message 37 indicates the source of the message and from where it was forwarded, if any.

Henderson, column 5, lines 52-55. Although this section cited by the examiner teaches including an identification from where the message was forwarded, this forwarding is not the same forwarding that occurs in the presently claimed invention in claim 1. The forwarding that occurs for the presently claimed invention is from one address for a recipient to another address for the recipient.

In contrast, the forwarding that occurs in *Henderson* has nothing to do with an old address that results in the message being forwarded to another address associated with the recipient. *Henderson* teaches that the header may include information identifying the different nodes in a route or path from the sender to the recipient. This teaching is clear from Figure 3, which is shown as follows:

FIG. 3

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37 { From sandi@research.att.com Wed Oct 23 22:08:12 1996
    Received: from montalin.research.att.com (montalin.research.att.com [135.16.210.14]) by
    learnx.research.att.com (8.7.5/8.7.3) with ESMTP id WAA05015 for <don@learnx.research.att.com>,
    Wed, 23 Oct 1996 22:08:11 -0400 (EDT)
    Received: from chara.research.att.com (chara.research.att.com [135.16.210.133])
    by montalin.research.att.com (8.7.5/8.7.3) with ESMTP id WAA00952 for <don@research.att.com>, Wed,
    23 Oct 1996 22:00:45 -0400 (EDT)
    From: Sandi ron Pier <sandi@research.att.com>
    Received: ((from sandi@localhost)) by chara.research.att.com (8.7.5/8.7.3) id WAA014150 for
    don, Wed, 23 Oct 1996 22:02:27 -0400 (EDT)
    Date: Wed, 23 Oct 1996 22:02:27 -0400 (EDT)
33 { Message-Id: <199610240202.WAA014150@chara.research.att.com>
34 { To: don@research.att.com
35 { Subject: l11wed-102496-1:00pm/102496-2:30pm Meeting at 2pm Thursday in Rm-4g323!
    Status: R
    A reminder:
36 { The Research meeting is 2pm, Thursday 10/24 in room 4g323...

    Sandi
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As can be seen, Figure 3 shows a header from an email message in section 37 that contains the source or sender of the message along with the different nodes that receive the message in routing the message to the recipient. This information is routing information for the message without any indication as to why the particular route was used. Nowhere, however, does *Henderson* teach, in the cited section or in the figure, indicating that the message has been forwarded from an old address. In other words, the forwarding mentioned in the cited section is the type forwarding that occurs in sending the message from the sender to the recipient in normal delivery of an email message, not forwarding of the message to another address associated with the recipient. The section shows the sending of the message to different nodes along a path from the sender to the recipient.

Even if the message was forwarded to another address associated with the recipient in the example show in Figure 3, nowhere does *Henderson* teach or suggest indicating that the message has been forwarded from an old address if the message is to be forwarded to another address associated with the recipient. Figure 3 only shows nodes that receive and send the message in a route or path from the sender to the recipient. No

indicator is shown or suggested in the cited section or in Figure 3. No indication is provided in Figure 3 or in the cited section as to whether a particular node or domain forwards the message because the message is to be forwarded to another address associated with the recipient. Consequently, the only forwarding that is taught in *Henderson* is showing the nodes that receive and forward the message along a path to the recipient. Therefore, including an indicator that forwarding from an old address has occurred is not taught or suggested by *Henderson*.

B. Stating that it is obvious to try or make a modification or combination without a suggestion in the prior art is not *prima facie* obviousness.

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

No teaching, suggestion, or incentive is present in *Henderson* for including an indicator identifying an email message as being forwarded from an old address if the message is to be forwarded to another address associated with the recipient. The mere fact that the routing information in *Henderson* could be modified to include an indicator that the message was forwarded from an old address does not make that modification obvious without some teaching, suggestion, or incentive based on these cited references or other prior art.

The examiner has provided a reason as to why the indicator of the present invention would be desirable. This reason, however, is not based on any suggestion or incentive in the prior art. Neither *Henderson* nor *McDowell* teach or suggest the indicator of the present invention. As shown above, *Henderson* teaches identifying nodes that route a message from a sender to a recipient. These identifiers, however, do not provide any indication as to whether the message is being forwarded from the old address if the message is to be forwarded to another address associated with the recipient.

C. When properly interpreted, combination proposed by the examiner does not reach the presently claimed invention.

When properly interpreted, *Henderson* teaches including header information identifying the route or path taken by the message from the sender to the recipient. This path is identified by including information about the nodes receiving and forwarding the message along the path to the recipient. Nowhere, however, does *Henderson* teach, suggest, or provide any incentive that the identification of these nodes indicates that a message has been forwarded from an old address if the message is to be forwarded to another address associated with the recipient. Therefore, a combination of *McDowell* and *Henderson* would result in including information identifying the route taken by the message to reach a recipient when messages are rerouted.

Therefore, the rejection of independent claims 1, 11, 12, and 22 have been overcome. The other claims rejected in this section are dependent claims depending from one of the independent claims. Therefore, the same distinctions between the cited references and the claimed invention in these independent claims apply to the dependent claims. Additionally, these dependent claims include other additional combinations of features not suggested by the cited references. Consequently, it is respectfully urged that the rejection of these claims have been overcome.

Therefore, the rejection of claims 1-2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 has been overcome.

II. 35 U.S.C. § 103(a), Obviousness

The examiner has rejected claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over *McDowell et al.*, United States patent number 6,438,583 ("*McDowell*") in view of *Henderson*, United States patent number 6,185,603 ("*Henderson*") in further view of *Berkowitz*, United States patent number 6,088,720 ("*Berkowitz*"). This rejection is respectfully traversed.

The rejection of these claims is traversed for the same reasons as stated above for independent claims 1, 11, 12, and 22 because these claims depend from the independent claims. Further, one of ordinary skill in the art would not combine *McDowell*, *Henderson*, and *Berkowitz* in the manner cited by the examiner. No teaching, suggestion,

or incentive is present for this combination. The examiner has combined *Berkowitz* with the other two references using rationales unsupported by the prior art.

One of ordinary skill in the art would not combine these references when they are considered as a whole. *McDowell* is directed towards problems associated with electronic messages being "bounced" back to the sender. *McDowell* solves this problem by providing a method and apparatus to attempt to reroute a message to a valid address. In contrast, *Henderson* is directed towards problems that occur when a user is unable to distinguish incoming mail messages providing alerts regarding received messages. *Henderson* provides a mechanism for alerting users about the content of a received message without the user having to read the entire message. *Berkowitz* is directed to problems that occur when a user has not accessed messages over an extended period of time, resulting in an accumulation of a large number of messages. *Berkowitz* provides a method and apparatus for self-cleaning of email boxes.

As can be seen, all three references are directed towards different problems and solutions when they are considered as a whole by one of ordinary skill in the art.

Therefore, the rejection of claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103(a) has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the above-cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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